

REMARKS

The Applicants thank the Examiner for the Office Action of December 19, 2008.

1) Status of Case

The case originally included claims 1 – 70. Those claims were cancelled in favor of a revised set of claims 71 – 194. Claims 71 – 194 were subject to restriction, and claims 71 – 94 were elected for further prosecution, claims 95 – 194 being non-elected claims.

In the Office Action of April 1, 2008, all of claims 71 – 94 were rejected under 35 USC 102(b) as being anticipated by US Patent 4,483,253 of List. Claims 72 – 75 were also rejected under 35 USC 112.

The Applicant submitted a response to Office Action on July 1, 2008 addressing these rejections.

By the Office Action of December 19, 2008 claims 72 – 74 were again rejected under 35 USC 112. In addition, claims 71 – 94 are now rejected under 35 USC 103 in view of US Patent 4,483,253 of List, rather than under 35 USC 102(b) as previously.

2) Supplemental Materials

The Applicant has become aware of a number of additional references. The supplemental references are:

- (a) White, John H., Jr., “The American Railroad Freight Car”
Johns Hopkins University Press, Baltimore, 1993
ISBN 0 – 8018 – 4404 – 5.
- (b) White, John H., Jr., “The American Railroad Passenger Car”
Johns Hopkins University Press, Baltimore, 1978
ISBN 0 – 8018 – 2743 – 4.
- (c) US Patent 2,071 of Davenport and Bridges issued May 4, 1841
- (d) US Patent 26,502 of Kipple and Bullock, issued December 20, 1859
- (e) US Patent 90,795 of Thielsen, issued June 1, 1869

- (f) US Patent 740,617 of Bettendorf, issued October 6, 1903
- (g) US Patent 2,301,726 of Kirsten, issued November 10, 1942
- (h) US Patent 2,483,858 of Van Der Sluys, issued October 4, 1949
- (i) US Patent 2,668,505 of Janeway, issued February 9, 1954

In addition, the Applicants draw to the Examiner's attention the following references, thought already to be of record in this case, namely:

- (j) US Patent 2,737,907 of Janeway, issued March 13, 1956
- (k) US Patent 3,461,814 of Weber et al., issued August 19, 1969
- (l) US Patent 3,670,660 of Weber et al., issued June 20, 1972
- (m) US Patent 4,483,253 of List, issued November 20, 1984
- (n) US Patent 4,179,995 of Day, issued December 25, 1979

Further, the Applicant notes two references cited by Examiner Le in co-pending case USSN 11 / 747,950, those references being:

- (o) US Patent 3,937,153 of Durocher, issued February 10, 1976
- (p) US Patent 3,352,255 of Sheppard issued November 14, 1967

The Applicant notes that Examiner Le has also cited in co-pending case USSN 11 / 747,950 the inventor James W. Forbes' own US Patents 6,659,016; 7,255,048; 7,267,059; and 7,328,659.

3) Rejection Under 35 USC 112 – Claims 72 - 75

The rejection asserts that claims 72 and 74 do not limit further the subject matter of claim 71 from which they depend. On that view the claims are redundant, being therefore improper dependencies. As the Applicants have previously noted, the rejection under 35 USC 112 still appears to arise out of the complicated grammatical structure of claim 71. That structure, which still exists notwithstanding the current amendments, in turn, arises out of the geometric relationship that the claim is attempting to address.

The Applicants have provided herewith a sketch that includes four Venn diagrams corresponding to claims 71, 72, 74, and 79 at the broadest conceptual level. Let the condition that the bearing adapter has the recited features be satisfied by domain "A". Let the condition

that the pedestal seat has the recited features be satisfied by domain “B”. Claim 71 is satisfied by the union set of (A OR B), the large cross-hatched area. Claim 72 is satisfied only by apparatus falling within domain “A”. Given that “A” is smaller than the union set of (A OR B), claim 72 is necessarily limiting over claim 71. Similarly, claim 74 is satisfied only by apparatus falling within domain “B”. As before, “B” is smaller than (A OR B), so claim 74 is necessarily limiting over claim 71. Therefore, claims 72 and 74, in adding further limitations to claim 71 are proper dependencies. For completeness, claim 79 claims the intersection set (A AND B), as illustrated. Once again, claim 79 is limiting over claim 71, and is therefore a proper dependency.

The Applicants continue to believe that the grammatical structure and inter-relationship of claims 71, 72 and 74 is, and always has been, correct. In the event that the Examiner continues to disagree, the Applicants request that the Examiner contact the Applicants’ representative by telephone so that appropriate steps may be taken to dispel any continuing misunderstanding or confusion on this point.

In any case, the Applicants request reconsideration and withdrawal of the rejections of claims 72 and 74 under 35 USC 112, and allowance of those claims and any claims dependent from them, namely claims 73 and 75.

4) Rejection Under 35 USC 103(a) – US Patent 4,483,253 of List

Claim 71 is directed toward a member having a self-steering apparatus fitting, be it a bearing adapter as in part (a) or a sideframe having a pedestal seat as in part (b) that has a “rolling contact engagement surface” that “has a fore-and-aft arcuate profile permitting rolling contact rocking of the wheelset bearing lengthwise relative to the sideframe”.

The List reference does not have the recited “rolling contact engagement surface”. It is not merely that List does not show an arcuate surface. List’s deflection is by bodily deformation of the elastomeric pad in shear. It is not a rolling contact condition. Nothing in List points to any such feature.

To emphasize that the members of the current claims are not elastomers deflecting in shear, claim 71 has been amended to indicate that the rolling contact surface is metal. This amendment ought to be unnecessary, given that the “rolling contact” feature already distinguishes List. In that light the Applicant’s reserve the right to continue prosecution of theses claims, for example by way of a continuation application, without the additional feature of

the surfaces being metal. The Applicant does not intend to concede, and does not concede claim scope under the Doctrine of Equivalents in consequence of this amendment. That is, the amendment is intended to encompass apparatus having rolling contact surfaces functionally equivalent to a metal rolling contact surface.

(d) Dependent Claims 72 - 89

All of claims 72 – 89 depend from claim 71. Insofar as claim 71 is allowable over the List reference, so also claims 72 – 89 are also allowable. On that ground, the Applicants request reconsideration and withdrawal of the rejections, and allowance of those dependent claims.

Further, List does not show, describe, or suggest the third member of claim 78, or of claims 83 – 85, and 89. Further still, List does not show, describe or suggest the bearing adapter having a relieved underside as claimed in claims 85, 87 and 88. The Office Action does not establish grounds for rejection of these claims by identifying prior art references having the noted features. The Applicant therefore requests reconsideration of the rejections of claims 78, 83 – 85, and 87 – 89 on these independent grounds.

To the extent that the Applicant respectfully submits that claims 78, 83 – 85 and 87 – 89 were allowable prior to the current amendments, the Applicants explicitly reserve the right to pursue protection for the subject matter of these claims as the stood prior to amendment, or with such other amendments as the Applicants may submit, by way of the filing of a continuation application.

(e) Claim 90

The Applicants make the same arguments with respect to claim 90 as made above in respect of claim 71.

(f) Dependent Claims 91 - 94

All of claims 91 – 94 depend from claim 90. To the extent that claim 90 is allowable over the List reference, so also are claims 91 – 94. On that ground, alone, the Applicants request reconsideration and withdrawal of the rejections, and allowance of those claims.

In addition, however, the Applicants also note that the Office Action does not identify in the List reference the resilient centering member of claim 93, or the bearing adapter relief of claim 94, and, on these additional grounds the Applicants request reconsideration of the rejections of those claims as well.

4) Amendments to the Claims

Independent claims 71 and 90 have been substantially amended. Consistent amendments have been made to many of the dependent claims. The Applicants believe that, as amended, all of the claims are currently allowable.

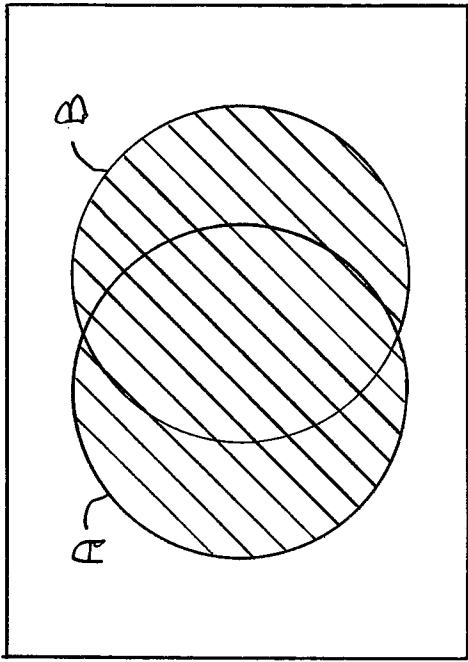
5) Conclusion

The Applicant respectfully submits that claims 71 – 94 currently pending in this case are currently in condition for allowance, and seeks early and favorable disposition of this matter.

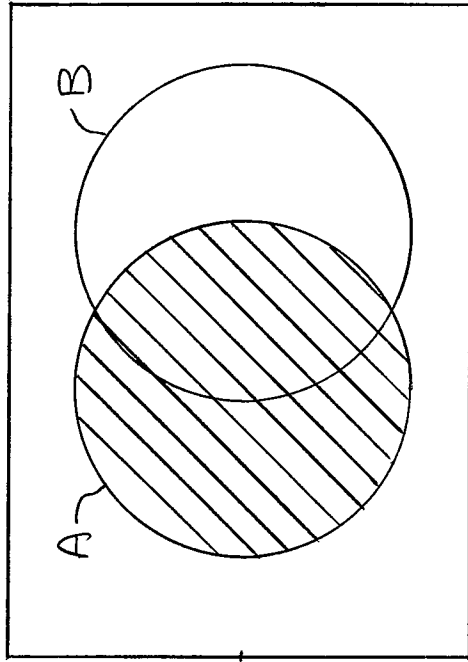
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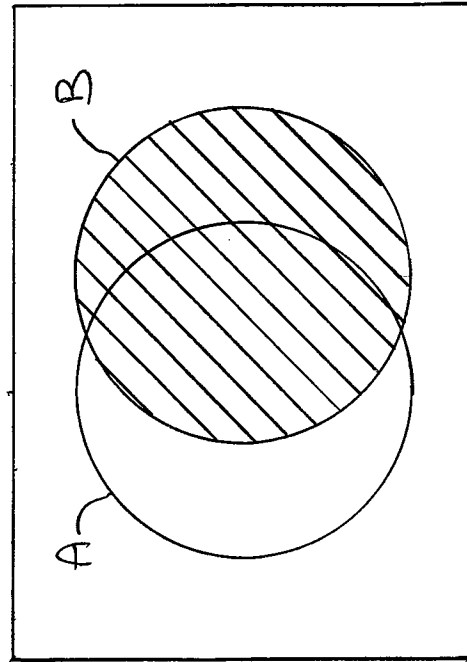
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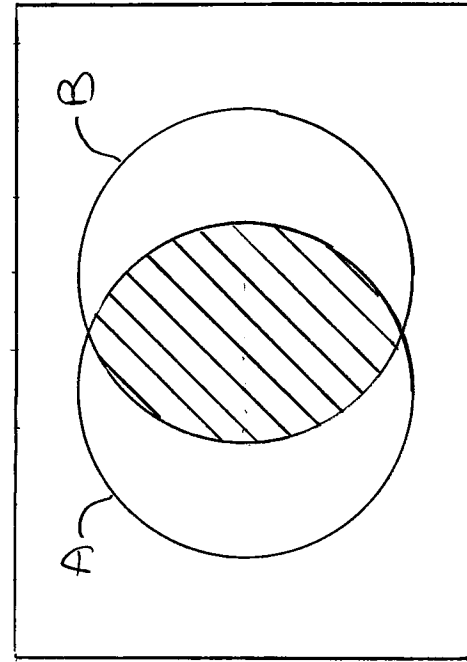
CLAIM 71 - A OR B



CLAIM 72 - A



CLAIM 74 - B



CLAIM 79 - A AND B